

REMARKS

In the above referenced Office Action, claims 1-15 were rejected under various grounds. Applicant respectfully traverses.

Claims 1-8 were rejected under 35 USC 103(a) over Velez. Applicant respectfully traverses. No *prima facie* case of obviousness has been provided and the rejection is unsupportable; therefore it must be withdrawn. Both the clear teachings of the reference as well as the Examiner's statements clearly establish that this rejection is inappropriate, incorrect and unsupportable.

Claim 1 is method of providing implantable medical devices. In a first model, the device has both a non-programmable memory (e.g., ROM) and a programmable memory (e.g., RAM) that may contain operating instructions. (ROM and RAM are used for convenience and not meant to be limiting). In a second model (not physically the same device as the first), the device only include the ROM and the previously claimed and present RAM is not included in this device. This is clearly and unambiguously claimed; articulated in the previous response; and set forth in the specification and drawings.

The Examiner states that "the Velez'765 reference does physically present both RAM and ROM in both device phases."

Velez states physically altering the RAM/ROM configuration is problematic. (Col. 3, lines 8-11).

Velez further states that each production unit is provided with both RAM and ROM. Col. 3, lines 12 – 13.

Velez further states that even the second phase production units can utilize RAM to affect programming changes. (Col. 3, lines 13-21).

Claim 1, presented in another form states that a method is provided to provide:

Model 1 having A and B and

Model 2, which does not include B.

The Examiner, however, argues that Applicant's positive and explicit recitation that Model 2 "does not include B" doesn't *really* "mean" not include B, but rather it

may include B if one simply ignores the presence of B. Applicant respectfully but regretfully expresses frustration with actually having argued this issue. The Examiner's statement that "'does not include' does not require the physical removal of the RAM unit, but merely a state in which the RAM is not used" is logically unsupportable and completely and explicitly ignores the clear, unambiguous, and unmistakable meaning of the claim wording.

To be perfectly clear, in claim 1 the subsequent model does not include, therefore it does not have; therefore there is no physical presence of the claimed RAM. Further, a device that has RAM, but at a given time does not use that RAM does not meet a limitation of a device the does not include RAM. To be clear, the RAM refereed to is that present in early models and absent in later models. Thus, despite the Examiner's unsupportable assertion to the contrary a model that "does not include" the claimed RAM does not physically have the specified RAM.

The Examiner's comment about physical removal is potentially misleading and as such, will be addressed. As indicated, the invention relates to producing medical devices and in earlier models both a specific RAM and ROM (again, these terms are used here for convenience in referring to the language of the claims) module are provided. In later devices, the ROM is provided but not the claimed RAM. The RAM chip is not removed from earlier devices. That is, an earlier model is not taken apart after completion to remove the RAM. It should be appreciated that RAM may be present in the devices for other purposes and the presently claimed embodiments do not exclude the presence of RAM in either model/build; but, rather define specific memory that is present in a first version and not present in a later version.

The Examiner then argues that it is "equivalent" to either not include the RAM in later builds (as claimed) or to continue to provide both the RAM and ROM, but rely on the ROM more, as taught by Velez. This is unsupportable. Velez clearly states that these are not equivalents. That is, removal of the RAM changes properties of the device, which according to Velez makes this action undesirable. As this reference is the only one cited and relied upon by the

Examiner, a modification or statement of equivalence that is unequivocally dispelled by the explicit teachings of the reference cannot stand.

The Examiner then argues that the omission of an element is obvious when its function is not desired. If the only difference between the claimed invention and the prior art were a given device and the number of parts, perhaps such an argument would have some relevance. However, when reading the claim as a whole and in context, such an argument is again, utterly unsupportable. The claim relates to a method of producing multiple IMDs. In early models, RAM and ROM are provided. Subsequently, in latter models the RAM is no longer provided. The function remains; that is, operating system commands are still stored in memory. Further, the Examiner's only cited reference again runs counter to the form paragraph rejection stating that it is undesirable to remove a RAM chip in later models. In other words, the Examiner cannot simply compare the later build to the prior art device but must consider the entire claim as a whole and in context which includes building different versions of a medical device.

The Examiner has rejected claims 9-15 under 35 USC 102(e) as being anticipated by Velez. The Examiner states that Applicant's arguments in the previous response were focused on claim 1 and its dependants and not necessarily claims 9-15 as these claims do not require the optional incorporation of a programmable memory but rather a device with the ability to detect/confirm the presence or absence of such a memory.

The Examiner asserts that Velez teaches this concept at Col. 8, lines 6-25. Applicant respectfully asserts that this is factually incorrect and is explicitly contradicted by the Examiner's own statements. Once again, the Examiner stated that:

the Velez'765 invention does physically present both RAM and ROM in both device phases.

As this is the case, how can the Examiner argue that Velez then anticipates a claim that detects whether RAM is *present* and takes one action when RAM is *present* and another action when RAM is *absent*? Including both components and selectively using them is certainly not the same nor equivalent to having only one component. Again, Velez is explicit that in both phases, the RAM is accessible and is utilized (see above citations). As this is not possible when the RAM is absent and Velez teaches away from providing only ROM, the rejection is clearly unsupportable and must be withdrawn. For these and similar reasons, a rejection under section 103 would likewise fail.

Applicant respectfully asserts that the pending claims are in condition for allowance and requests notice of the same. Should any issues remain outstanding, the Examiner is urged to telephone the undersigned to expedite prosecution. The Commissioner is authorized to charge any deficiencies and credit any overpayments to Deposit Account No. 13-2546.

Respectfully submitted,

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